



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|-----------------------|-----------------------|------------------|
| 09/994,466 | 11/26/2001 | Ragupathy Madiyalakan | AREX-P03-002 | 7223 |
| 28120 | 7590 | 06/06/2005 | EXAMINER | |
| FISH & NEAVE IP GROUP ROPES & GRAY LLP ONE INTERNATIONAL PLACE BOSTON, MA 02110-2624 | | | HUFF, SHEELA JITENDRA | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1642 | |

DATE MAILED: 06/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|---|--|
| Office Action Summary | Application No. 09/994,466 | Applicant(s) MADIYALAKAN, RAGUPATHY | |
| | Examiner Sheela J. Huff | Art Unit 1642 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1,2,5-11,16-18,21-23,25-29 and 42-47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,5-11,16-18,21-23,25-29 and 42-47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

2

DETAILED ACTION

The finality of the paper mailed 11/30/04 is withdrawn and prosecution is hereby re-opened.

All of the previous rejections are withdrawn either in view of applicant's arguments or amendments or in view of the terminal disclaimer.

Claims 1-2, 5-11, 16-18, 21-23, 25-29 and 42-47 are pending.

Claim Rejections - 35 USC § 112

Claims 1-2, 5-11, 16-18, 21-23, 25-29 and 42-47 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Factors to be considered in determining whether a disclosure meets the enablement requirement of 35 USC 112, first paragraph, have been described in *In Re Colianni*, 195 USPQ 150 (CCPA 1977) and have been adopted by the Board of Patent Appeals and Interferences in *Ex Parte Forman*, 230 USPQ 546 (BPAI 1986). Among these factors are:

1. the nature of the invention,
2. the state of the prior art,
3. the predictability or lack thereof in the art,
4. the breath of the claims,
5. the amount of direction or guidance present, and
6. the presence or absence of working examples.

The following is an analysis of these factors in relationship to this application.

Applicant discloses and claims a method for treating tumors using any antibody that binds the same epitope as PTA-975. As stated in the specification the epitope includes amino acids and carbohydrate (see page 5, lines 15-17 of the specification).

Recognition of carbohydrate moieties bound by antibodies is a complex and unpredictable task. Unlike linear amino acid epitopes, which can be readily synthesized in vitro and against which other antibodies can be readily made, carbohydrate epitopes are more complex and difficult to synthesize. Knight (BioTechnology Vol 7 No 1, Jan 1989) likens this task to "wrestling with a cloud". She states that "prediction and control of the expression of oligosaccharide remains elusive and threatens to remain so from some time" and the challenge is "a daunting one". Knight goes on to explain that "the structure of carbohydrates is much more complex than that of proteins. Dwek likens the task of sequencing a carbohydrate to "simultaneously sequencing 40 or 50 proteins". Because carbohydrate structures are a branching series of linked rings, they can combine in many more ways than linear peptide chains. For comparison, consider that while three amino acids can combine in only six ways, three carbohydrate monomers can form over 1,000 different trisaccharide structures" (see page 39, first column, third and fourth full paragraphs). One skilled in the art would reasonably conclude that, even if one had known that the PTA-975 epitope comprised carbohydrate moieties, the synthesis of potential carbohydrate moieties would require undue experimentation.

Even if one skilled in the art were able to identify a region of a glycosylated protein that bound a particular antibody, Knight teaches the unpredictability of knowing the exact structure found in that glycoprotein. Knight states that "on top of this amazing diversity, nature adds what glycobiologists call "micro heterogeneity" in the form of

Art Unit: 1642

discrete subsets -glycoforms- of a glycoprotein. These may have difference physical and biochemical properties.” One skilled in the art would reasonably conclude that these different physical and biochemical properties encompass expression of different epitopes. Knight summarize that “the “demographics” of its glycoform population determine the composite activity of a glycosylated compound. According to Rademacher, Parekh and Dwek, “Any given glycoprotein that consists of different glycoforms will... have a composite activity, reflecting a weighted average of the activity and incidence of each glycoform” (page 39, third column, second full paragraph).

In summary, antibodies bind to structural shapes that may be linear stretches of amino acids, conformational determinants formed by the folding of peptides, carbohydrate moieties, phosphate or lipid residues or a combination thereof. The nature of the PTA-975 epitope was unknown at the time of filing. While multiple antibodies can be readily made to linear peptide sequences, the same is not true of antibodies that recognize non-linear conformational determinants such as carbohydrate epitopes. Therefore, in weighing the factors to be considered in determining whether or not the practice of a claimed invention would require “undue” experimentation, as set forth in *In re Wands* (8 USPQ 2d at 1404), the weight of the analysis clearly favors a finding of “undue” experimentation.

Conclusion

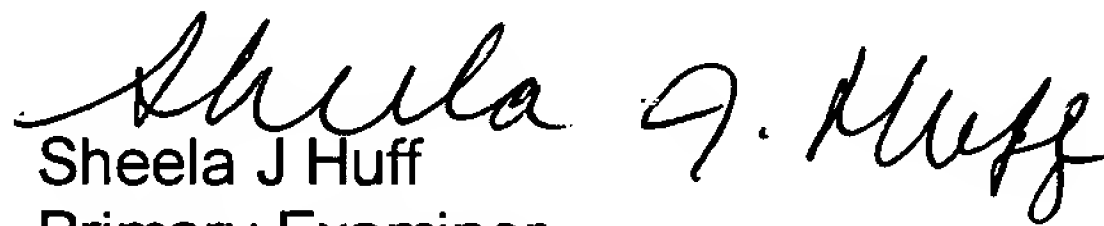
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sheela J. Huff whose telephone number is 571-272-

Art Unit: 1642

0834. The examiner can normally be reached on Mondays and Thursdays from 5:30am to 2:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Siew can be reached on 571-272-0787. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Sheela J Huff
Primary Examiner
Art Unit 1642

sjh